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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,811	11/16/2007	Richard Spitz	10191/4496	8036
26646 7590 10/27/2010 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
PHAM, EMILY P				
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2838				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/566,811

**Applicant(s)**

SPITZ ET AL.

**Examiner**

Emily Pham

**Art Unit**

2838

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9, 11, 13, 15, 17, & 19-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 11, 13, 15, 17 and 19-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date ????
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is in response to the RCE filed on 10/04/2010.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/04/2010 has been entered.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9, 11, 13, 15, 17, 19, 20, 22, 23, 24, 25, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Dibugnara (USP 3,844,029).

Regarding independent claim 9: AAPA (**For example: see FIG 1, par [0003] – par [0006]**) discloses a press-fit diode (**(1)**), comprising a diode chip (**(7)**); a base contact (**(3)**) for pressing the press-fit diode (**(1)**) into a substrate, wherein the base contact (**(3)**) is

attached to the diode chip **(7)** and forms a first terminal of the press-fit diode **(1)**; and a wire contact **(2, 4)** which forms a second terminal of the press-fit diode **(1)**, wherein the wire contact **(2, 4)** is attached to the diode chip **(7)**, and wherein a section of the wire contact attached to the diode chip is covered with the nickel layer without the silver layer being directly applied on the nickel layer **(the wire contact section has only nickel layer)**.

AAPA fails to disclose the silver layer is directly applied on a nickel layer and the wire contact is at least partially provided with a silver layer and the silver layer is directly applied on a nickel layer.

However, Dibugnara **(For example: see lines 30-32 of col. 10)** teaches the silver layer is directly applied on a nickel layer and the wire contact at least partially **(the exposed end of wire)** provided with a silver layer **(silver layer)** and the silver layer **(silver layer)** is directly applied on a nickel layer **(nickel layer)**. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the press-fit diode of AAPA to include the wire contact at least partially provided with a silver layer by Dibugnara, for the purpose of providing necessary soldering characteristics.

Additionally, since AAPA and Dibugnara are from the same field of endeavor, the purpose taught by Dibugnara would have been recognized in the pertinent arts of AAPA.

Regarding claim 11: AAPA **(For example: see FIG 1)** discloses the base contact is not provided with a silver layer.

Regarding independent claim 13: AAPA (**For example: see FIG 1, par [0003] – par [0006]**) discloses a method for manufacturing a press-fit diode, comprising: providing a diode chip; providing a base contact configured for pressing the press-fit diode into a substrate, wherein the base contact forms a first terminal of the press-fit diode; providing a wire contact which forms a second terminal of the press-fit diode, and wherein a section of the wire contact attached to the diode chip is covered with the nickel layer without the silver layer being directly applied on the nickel layer (**the wire contact section has only nickel layer**); and fixedly connecting the wire contact, the base contact, and the diode chip to one another.

AAPA fails to disclose the wire contact is at least partially provided with a silver layer and the silver layer is directly applied on a nickel layer.

However, Dibugnara (**For example: see lines 30-32 of col. 10**) teaches the wire contact at least partially (**the exposed end of wire**) provided with a silver layer (**silver layer**) and the silver layer (**silver layer**) is directly applied on a nickel layer (**nickel layer**). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the press-fit diode of AAPA to include the wire contact at least partially provided with a silver layer by Dibugnara, for the purpose of providing necessary soldering characteristics.

Additionally, since AAPA and Dibugnara are from the same field of endeavor, the purpose taught by Dibugnara would have been recognized in the pertinent arts of AAPA.

Regarding claim 15: AAPA (**For example: see FIG 1**) discloses the base contact is not provided with a silver layer.

Regarding claim 17: AAPA (**For example: see FIG 1, paragraph [0006]**) discloses the wire contact is made of copper, and the wire contact is further provided with a nickel layer

AAPA fails to disclose the silver layer is applied on a nickel layer.

However, However, Dibugnara (**For example: see lines 30-32 of col. 10**) teaches the silver layer (**silver layer**) is applied on a nickel layer (**nickel layer**). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the press-fit diode of AAPA to include the wire contact with a silver layer applied on a nickel layer by Dibugnara for the purpose of providing necessary soldering characteristics.

Additionally, since AAPA and Dibugnara are from the same field of endeavor, the purpose taught by Dibugnara would have been recognized in the pertinent arts of AAPA.

Regarding claims 19 and 24: AAPA fails to disclose the silver layer is applied before the press-fit diode is assembled.

However, Dibugnara (**For example: see FIG 7, FIG 9**) teaches the silver layer (**38a**) is applied before the press-fit diode (**diode**) is assembled (**FIG 9**). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the press-fit diode of AAPA to include the silver layer applied before the press-fit diode is assembled by Dibugnara for the purpose of properly coating the wire.

Additionally, since AAPA and Dibugnara are from the same field of endeavor, the purpose taught by Dibugnara would have been recognized in the pertinent arts of AAPA.

Regarding claims 20 and 25: AAPA **(For example: see FIG 1, paragraph [0003])** discloses the press-fit diode as recited in claim 9, wherein a region for attaching the diode chip is recessed.

Regarding claims 22 and 27: AAPA **(For example: see FIG 1)** discloses a central section of the press-fit diode is sheathed in plastic **(9; For example: see par [0006])** to protect the diode chip.

Regarding claims 23 and 28: AAPA **(For example: see par [0007])** discloses the press-fit diode is electroplated in bulk in a drum process **(electroplated in bulk in a drum tin plating process)**.

Finally, the following limitations of claims 19, 21, 22, 23, and 29 make them a product by process claim: a) "the silver layer is applied before the press-fit diode is assembled"; b) "the wire contact is inserted in a rack with a wire shaft pointing downward, and wherein the wire shaft is immersed in an electroplating vat" ; c) "a central section of the press-fit diode is sheathed in plastic to protect the diode chip"; d) "press-fit diode is electroplated in bulk in a drum process"; and "wherein the silver layer is applied before the press-fit diode is assembled, wherein a region for attaching the diode chip is recessed, wherein the wire contact is inserted in a rack with a wire shaft pointing downward, wherein the wire shaft is immersed in an electroplating vat, wherein a central section of the press-fit diode is sheathed in plastic to protect the diode chip,

and wherein the press-fit diode is electroplated in bulk in a drum process". The MPEP § 2113, states, "Even though product -by-[-] process claims are limited by and defined by the process, determination of patentability is based upon the product itself. The patentability of a product does not depend on its method of production. If the product in product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product is made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985)(citations omitted).

A "product by process" claim is directed to the product per se, no matter how actually made, *In re Hirao and Sato et al.*, 190 USPQ 15 at 17 (CCPA 1976) (footnote 3). See also *In re Brown and Saffer*, 173 USPQ 685 (CCPA 1972); *In re Luck and Gainer*, 177 USPQ 523 (CCPA 1973); *In re Fessmann*, 180 USPQ 324 (CCPA 1974); and *In re Marosi et al.*, 218 USPQ 289 (CAFC 1983) final product per se which must be determined in a "product by, all of" claim, and not the patentability of the process, and that an old or obvious product, whether claimed in "product by process" claims or not. Note that Applicant has the burden of proof in such cases, as the above caselaw makes clear.

5. Claims 21, 26, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Dibugnara (USP 3,844,029), and further in view of Wang et al (USP 7,361,257).

Regarding claims 21 and 26: AAPA fails to disclose the wire contact is inserted in a rack with a wire shaft pointing downward, and wherein the wire shaft is immersed in an electroplating vat.



However, Wang et al (**For example: see FIG 13, lines 52-53 of col. 14**) teaches the wire contact (**electrode**) is inserted in a rack (**170**) with a wire shaft (**shaft of electrode**) pointing downward, and wherein the wire shaft (**shaft of electrode**) is immersed (**For example: see line 19 of col. 17: partially immersed**) in an electroplating vat (**electrolyte bath**). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the press-fit diode of AAPA to include the wire contact inserted in a rack with a wire shaft pointing downward and the wire shaft immersed in an electroplating vat by Wang et al for the purpose of effectively coating the wire shaft.

Additionally, since AAPA and Wang et al are from the same field of endeavor, the purpose taught by Wang et al would have been recognized in the pertinent arts of AAPA.

Regarding claim 29: AAPA (**For example: see FIG 1**) discloses a region for attaching the diode chip is recessed, a central section of the press-fit diode (**1**) is sheathed in plastic (**9**) to protect the diode chip (**7**), and the press-fit diode (**1**) is electroplated in bulk in a drum process (**For example: see par [0007], electroplated in bulk in a drum tin plating process**).

AAPA fails to disclose the silver layer is applied before the press-fit diode is assembled.

However, Dibugnara (**For example: see FIG 7, FIG 9**) teaches the silver layer (**38a**) is applied before the press-fit diode (**diode**) is assembled (**FIG 9**). It would have been obvious to a person having ordinary skill in the art at the time the invention was

made to modify the press-fit diode of AAPA to include the silver layer applied before the press-fit diode is assembled by Dibugnara for the purpose of properly coating the wire.

Additionally, since AAPA and Dibugnara are from the same field of endeavor, the purpose taught by Dibugnara would have been recognized in the pertinent arts of AAPA.

Furthermore, AAPA fails to disclose the wire contact is inserted in a rack with a wire shaft pointing downward, wherein the wire shaft is immersed in an electroplating vat.

However, Wang et al (**For example: see FIG 13, lines 52-53 of col. 14**) teaches the wire contact (**electrode**) is inserted in a rack (**170**) with a wire shaft (**shaft of electrode**) pointing downward, wherein the wire shaft is immersed in an electroplating vat (**electrolyte bath**). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the press-fit diode of AAPA to include inserting the wire contact in a rack with a wire shaft pointing downward; immersing the wire shaft in an electroplating vat by Wang et al for the purpose of effectively coating the wire shaft.

Additionally, since AAPA and Wang et al are from the same field of endeavor, the purpose taught by Wang et al would have been recognized in the pertinent arts of AAPA.

Regarding claim 30: AAPA AAPA (**For example: see FIG 1**) discloses a region for attaching the diode chip is recessed, sheathing (**9**) a central section of the press-fit diode to protect the diode chip (**7**); wherein the press-fit diode (**1**) is electroplated in bulk

in a drum process (**For example: see par [0007], electroplated in bulk in a drum tin plating process**).

AAPA fails to disclose inserting the wire contact in a rack with a wire shaft pointing downward; immersing the wire shaft in an electroplating vat.

However, Wang et al (**For example: see FIG 13, lines 52-53 of col. 14**) teaches inserting the wire contact (**electrode**) in a rack (**170**) with a wire shaft (**shaft of electrode**) pointing downward; immersing the wire shaft (**shaft of electrode**) in an electroplating vat (**electrolyte bath**). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the press-fit diode of AAPA to include inserting the wire contact in a rack with a wire shaft pointing downward; immersing the wire shaft in an electroplating vat by Wang et al for the purpose of effectively coating the wire shaft.

Additionally, since AAPA and Wang et al are from the same field of endeavor, the purpose taught by Wang et al would have been recognized in the pertinent arts of AAPA.

### ***Response to Arguments***

6. Applicant's arguments filed 10/04/2010 have been fully considered but they are not persuasive.

In response to applicant's argument that Dibugnara (USP 3,844,029) fails to disclose or even suggest a wire contact being "covered with the nickel layer without the silver layer directly applied on the nickle layer", it is noted that claim 9 is rejected by

combination of AAPA and Dibugnara as well as claim 13 is rejected by combination of AAPA and Dibugnara. AAPA discloses a section of the wire contact attached to the diode chip is covered with the nickel layer without the the silver layer directly applied on the nickel layer (For example: see FIG 1). However, AAPA was utilized to disclose that limitation and not Dibugnara. Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking Dibugnara individually where the rejections are based on combinations of AAPA and Dibugnara. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, Applicant argued that "any Official Notice is respectfully traversed ... it is respectfully requested that the Examiner provide an affidavit and /or that the Examiner published information concerning these assertions." It is not clear what Applicant is arguing because official note was not taken.

#### ***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Pham whose telephone number is (571)270-3046. The examiner can normally be reached on Mon-Thu (7:00AM - 6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Lewis can be reached on (571) 272 - 1838. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Monica Lewis/  
Supervisory Patent Examiner, Art Unit 2838

October 16, 2010  
/EP/  
Examiner, Art Unit 2838